

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 3 and 8 are pending in the application, with claim 1 being the independent claim. Claims 2 and 4-7 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claim 1 has been amended. Support for the amendment to claim 1 can be found in claim 1 as originally filed and the specification on page 2, lines 3-8. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Description of the Invention

The present invention relates to, *inter alia*, the use of 2,2-dimethyl-3-(2,4-dichlorophenyl)-2-oxo-1-oxaspiro[4,5]dec-3-en-4-yl butanoate (compound I) for controlling acarids in hops, soft fruits and conifers.

II. Rejections under 35 U.S.C. § 112, second paragraph

Rejection of claim 1-8 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention is respectfully traversed. In view of the cancellation of claims 2 and 4-7, the rejection of claims 2 and 4-7 is rendered moot. The Office states that it is unclear what Applicant intends by "species" or what is encompassed by the term "species." Applicants have amended claim 1 to delete the term

"species." In view of this amendment, Applicants respectfully request that the rejection be withdrawn.

III. Rejections Under 35 U.S.C. § 102

A. Rejection Under 35 U.S.C. § 102(b)

Rejection of claims 1 and 3 under 35 U.S.C. § 102(b) as allegedly being anticipated by Wachendorff, U. et al., "BAJ, a novel broad spectrum acaricide," *Proceedings of the Brighton Crop Protection Conference-Pests and Diseases* 1:53-58, 2000 ("Wachendorff"), is respectfully traversed.

Claim 1 has been amended to recite a method of controlling acarids comprising contacting a compound of formula I (spirodiclofen) with hops, soft fruits and conifers. Wachendorff discloses the use of spirodiclofen in citrus, pome fruits, stone fruits, grapes and nuts. Wachendorff does not disclose the use of spirodiclofen in hops, soft fruits and conifers. Therefore, Wachendorff does not teach each and every element of the claim. Applicants respectfully request that the rejection be withdrawn.

B. Rejection Under 35 U.S.C. § 102(a)

Rejection of claims 1, 3 and 4 under 35 U.S.C. § 102(a) as allegedly being anticipated by Elbert *et al.* "Worldwide uses of the new acaricide Envidor® in perennial crops," *Pflanzenschutz Nachrichten Bayer* 55:287-304, 2002 ("Elbert"), is respectfully traversed. In view of the cancellation of claim 4, the rejection of claim 4 is rendered moot.

Claim 1 has been amended to recite a method of controlling acarids comprising contacting a compound of formula I (spirodiclofen) with hops, soft fruits and conifers. Elbert discloses the use of spirodiclofen on fruits such as citrus, pome and stone fruits,

grapes and almonds. Elbert does not indicate that spirodiclofen may be used in hops, soft fruits and conifers. Therefore Elbert does not teach each and every element of the claim. Applicants respectfully request that the rejection be withdrawn.

IV. Rejections Under 35 U.S.C. § 103(a)

Rejection of claim 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wachendorff in view of U.S. Patent No. 5,380,732 ("Blade") is respectfully traversed. In view of the cancellation of claim 4, the rejection of claim 4 is rendered moot. Applicants respectfully request that the rejection be withdrawn.

Rejection of claims 2 and 5-8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wachendorff in view of Blade is respectfully traversed. In view of the cancellation of claims 2 and 5-7, the rejection of claims 2 and 5-7 are rendered moot. Applicants respectfully traverse the rejection of claim 8.

Claim 8 recites a method of controlling acarids in conifers comprising contacting a compound of formula I with conifers. The Office states that Wachendorff teaches the use of spirodiclofen on various crops but does not specifically teach the use of spirodiclofen on kiwi fruits, coffee, spices, tropical fruits and conifers. The Office alleges that this deficiency is cured by the teachings of Blade. Office Action, p. 7. Applicants respectfully disagree.

Blade teaches pesticidal compounds having a completely different structure than the claimed compounds. The Office states that "one of ordinary skill in the art would have been motivated" to apply the instant compounds to the instantly claimed crops because Blade teaches that acaricides can be applied to various crops for the purpose of protecting crops from infestation from pests. Office Action, p. 8. Applicants

respectfully disagree. The compounds of Blade are completely different in structure from spirodiclofen. In fact, Blade does not even teach spirodiclofen. Blade also does not provide a person of ordinary skill in the art any indication that the compounds disclosed therein may be substituted with spirodiclofen. Applicants respectfully request that the rejection of claim 8 be withdrawn.

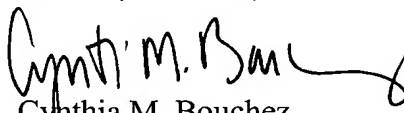
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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